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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,459	08/08/2003	Anjali Abhimanyu Patil	Rev 03-20	3432

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EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/637,459		PATIL ET AL.	
	Examiner		Art Unit	
	James W. Rogers, Ph.D.		1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,6,8-11,13-18,21,22,24,25 and 28-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7,12,19,20,23,26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/08/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicants election of the linear volatile siloxane and the film forming polymer is noted. For the lipophilic particulate and the multifunctional component the examiner noticed that applicants brought in the following new limitations to the species which were not claimed nor amended into the claims: a mono, di or trimer oil for the multifunctional component and a lipophilic particulate having a particle size ranging from 0.5-200 microns. To expedite the examining process the examiner simply searched for the following species that were claimed: a lipophilic non-pigmentitious particulate and a multifunctional component comprising an ester. Applicants claim that claims 2,4,7,12,19-20,23,26,27,31,33 and 36 read on the elected species. The examiner disagrees; claim 31 claims a volatile parafinic hydrocarbon that is a multifunctional component as described in applicant's specification, therefore claims 31,33 and 36 are withdrawn from consideration by the examiner since applicants did not elect a volatile parafinic hydrocarbon as the multifunctional component. Examiner notes that claim 1 must be searched since all claims now searchable depend upon it; therefore the examiner searched claims 1,2,4,7,12,19-20,23,26 and 27.

Claim Rejections - 35 USC § 112

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically claim 1 is indefinite because it is not clear what "A long wearing cosmetic composition" would encompass, for instance how long must the

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cosmetic be worn before it is considered long wearing. To expedite the examining process the examiner simply searched for a composition that would meet all of the limitations for the ingredients, since the same composition will have the same properties, such as how long the composition can be worn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,4,7,12,19-20,23,26 and 27 are rejected under 35 U.S.C. 102(a) and 35 U.S.C. 102(e) as being anticipated by Ferrari et al. (US 2002/0164297).

Ferrari teaches a cosmetic composition useful as a lipstick comprising polymers such as acrylic-silicone copolymers, volatile oils such as octamethyltrisiloxane, fatty esters (meets limitation for a multifunctional component) and numerous fillers (including talc, mica, boron nitride ect. all taught as lipophilic non-pigmentitious particulates in applicants specification, see pag 27 last paragraph-page 28 2nd paragraph). See abstract, [0054]-[0055], [0060]-[0062],[0121], claims 1,12,14 and 25. Regarding claim 12 which states the composition comprises two or more film forming polymers, Ferrari inherently teaches the use of more than one polymer of the film forming polymer since

the polymers can be up to 60% of the weight of the composition, it is inherent that there are an enormous number of polymers in the composition. The examiner realizes that applicants probably meant to limit the claim to two types of film-forming polymers in the composition, in which case Ferrari still teaches that the polymers such as acrylic-silicone copolymers, silicone polyurethanes and silixone polymers can be used in mixtures, thus meeting the limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,2,4,7,12,19-20,23,26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrari et al. (US 2002/0164297).

Ferrari is disclosed above. The volatile solvents such as octamethyltrisiloxane appear to be optional components of the cosmetic composition in Ferrari. It would have been obvious however for the skilled artisan to use a volatile oil such as octamethyltrisiloxane from the following disclosure within Ferrari: "These volatile solvents are favorable towards the production of a deposit of good staying power. After these solvents have evaporated off, a supple film-forming deposit that is not sticky on the skin or the lips is obtained. These volatile solvents also facilitate the application of the composition to the skin, the lips and integuments". Thus it would have been obvious to the skilled artisan to use the volatile solvents disclosed within Ferrari in cosmetic compositions with the disclosed advantages of good staying power and leaving behind after they evaporated a supple film-forming deposit that is not sticky on the skin or the lips.

Double Patenting

Claims 1,7,12,19,23 and 26 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,6-14 and 18-20 of copending Application No. 10/364,245.

This is a provisional obviousness-type double patenting rejection.

Specifically both applications claim a cosmetic composition comprised of a film-forming polymer that is a silicone-acrylate copolymer, a volatile silicone, a non-pigmentitious powder and a multifunctional component such as a wax.

Claims 1,7,12,19,23,26 and 27 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,6-14 and 18-20 of copending Application No. 10/960,557.

This is a provisional obviousness-type double patenting rejection.

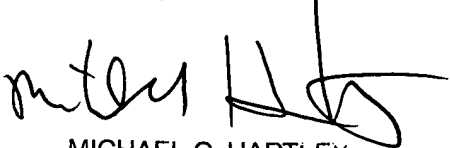
Specifically both applications claim a cosmetic composition comprised of a film-forming polymer that is a silicone-acrylate copolymer, a volatile silicone, a non-pigmentitious powder and a multifunctional component such as fatty esters.

Conclusion

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER